

REMARKS/ARGUMENTS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1-6, 8-17, 27 and 29 are now pending.

Claims 1, 3-6, 14-17, 27, and 29 were rejected under 35 USC 102(b) as being anticipated by Schill et al. Applicant respectfully traverses this rejection.

Claims 1 and 15 have been amended above to incorporate the feature of claims 7, 9, and 28, specifically that the capacitor (78 in the illustrated embodiment) is disposed in a location corresponding to the recessed portion 300 which is formed between two adjacent coils 62. This is illustrated, for example, in Figure 6 and 7 and discussed on page 15 of the specification. Because the location of the capacitor corresponds to the recessed portion between adjacent coils, the total length of the motor can be shortened. In an example embodiment, the recessed portion 300 is formed between the coils 62 because each coil 62 is wound around respective bobbin 60 in a concentrated manner so that a recess is defined adjacent the end of the adjacent coils.

Anticipation under Section 102 of the Patent Act requires that a prior art reference disclose every claim element of the claimed invention. See, e.g., Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1574 (Fed. Cir. 1986). While other references may be used to interpret an allegedly anticipating reference, anticipation must be found in a single reference. See, e.g., Studiengesellschaft Kohle, G.m.b.H. v. Dart Indus., Inc., 726 F.2d 724, 726-27 (Fed. Cir. 1984). The absence of any element of the claim from the cited reference negates anticipation. See, e.g., Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 715 (Fed. Cir. 1984). Anticipation is not shown even if the differences between the claims and the prior art reference are insubstantial and the missing elements could be supplied by the

knowledge of one skilled in the art. See, e.g., Structural Rubber Prods., 749 F.2d at 716-17.

Schill discloses capacitors 47 disposed inside a rotating member comprised of a commutator and an armature. Schill does not, however, anticipate the invention claimed by applicant. Although Schill discloses that capacitor 47 is mounted adjacent commutator 31 of fuel pump 3, Schill does not disclose that the capacitor 47 is disposed in a location corresponding to a recessed portion between adjacent coils. In this regard, it is respectfully submitted that the Examiner has misidentified certain component parts of Schill. For example, the Examiner assumes that member 33 (Kommutatorbursten in German) represents the commutator in Schill. It is respectfully submitted, however, that consistent with Schill's abstract, member 31 (Kommutator in German) represents the commutator in Schill. Further, the Examiner has referred to coils 14 in Schill. However, a review of the illustrations and disclosure of Schill reveals that no component part is labeled as nor referenced as element 14. Even if member 23 (Rotorwicklungen in German) represents the coil in Schill, it is respectfully submitted that Schill does not "obviously" disclose a member corresponding to the coil 62 of applicant's invention, as characterized in applicant's claims. Indeed, there is no disclosure of any recessed portion formed between adjacent coils and certainly no disclosure of locating the capacitor 47 so as to correspond to such a recessed portion. Likewise, Schill does not teach or suggest a structure which allows the length of the motor to be axially reduced. Indeed, there is no disclosure that coil 23 is wound in a concentrated manner so as to define a recessed portion nor that the commutator is aligned with such a recessed portion to reduce the length of the motor. It is therefore respectfully submitted that claims 1 and 15 are not anticipated by nor obvious from Schill.

The dependent claims are allowable at least by virtue of their dependence upon the respective independent claims noted above.

Claims 2 and 11 were rejected under 35 USC 103(a) as being unpatentable over Schill in view of Zepp. Applicant respectfully traverses this rejection.

These claims are submitted to be patentable over Schill for the reasons advanced above. The Examiner's further reliance on Zepp does not overcome the deficiencies of the primary reference noted above. It is therefore respectfully submitted that these claims are also allowable.

Claims 7-10 and 28 were rejected under 35 USC 103(a) as unpatentable over Schill et al in view of Matsushita. Applicant respectfully traverses these rejections.

As noted above, the limitations of claims 7 and 28 have been incorporated into amended claims 1 and 15 respectively. Claims 1 and 15 are submitted to be distinct from Schill for the reasons advanced above. The Examiner's further reliance on Matsushita does not overcome the deficiencies of Schill.

The Examiner characterized Matsushita as showing a recess portion formed between poles 3-1 to 3-4 and a capacitor 5 allegedly located in the recessed portion. Actually, what Matsushita describes is that the capacitors 5 are disposed in slots defined by the core arms, but because Matsushita completely omits the windings from his Figure 1, and because that structure cannot readily be correlated with the schematic illustration of Figure 13, it cannot be determined from Matsushita how the capacitor is positioned relative to the commutator contact face and how the capacitor is positioned relative to the coils. Moreover, from Figure 1 of Matsushita it appears that the capacitors of Matsushita are disposed so that they are exposed at a peripheral surface of a rotating member comprised of the commutator and the armature, which is itself contrary to claim 1 of this application.

Schill clearly discloses that the capacitor 47 is mounted in a receptacle disposed on the under face of commutator segment 53 and is remote from the coils. In the absence of applicant's disclosure, one skilled in the art would not "obviously" abandon

the Schill invention relating to the disposition of the capacitor and completely reconstruct Schill to provide the commutator between core arms as allegedly disclosed in Matsushita.

It is clear that the initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. In re Piasecki, 745 F. 2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to arrive at the claimed invention from the prior art. Ex parte Clapp, 227 USPQ 972 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp. 837 F.2d 1044, 7 USPQ 2d 1434 (Fed. Cir. 1988).

Even if a combination of Schill and Matsushita were attempted, it is respectfully submitted that the result would be contrary to claim 1 because the capacitor as so disposed would be exposed at a periphery of the rotating member. Even further, the capacitor as so disposed would not be axially between the commutator and a recessed portion between adjacent wound coils. The dependent claims would also not be satisfied by the Examiner's proposed combination of Schill and Matsushita. For example, claim 4 requires that the capacitor be disposed in the commutator which is not possible with the Matsushita configuration. In view of the foregoing, it is respectfully submitted that contrary to the Examiner's characterization of Schill and Matsushita, one skilled in the art would not obviously modify Schill in view of Matsushita and the result of such a combination would not meet the limitations of applicant's claim 1, claim 15, or the dependent claims.

In view of the foregoing, reconsideration and withdrawal of the rejection based on Schill and Matsushita is solicited.

Claim 12 was rejected under 35 USC 103(a) as being unpatentable over Schill et al in view of Bahn. Applicant respectfully traverses this rejection.


Claim 12 is submitted to be patentable over the primary referenced for the reasons advanced above. The Examiner's further reliance on Bahn does not overcome the deficiencies of Schill noted above.

Claim 13 was rejected under 35 USC 103(a) as being unpatentable over Schill et al. Applicant respectfully traverses this rejection. Claim 13 is submitted to be patentable over Schill for the reasons advanced above with respect to claim 1.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

Respectfully submitted,

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